REMARKS

Claims 8-33, 48, 49, 51, and 52 are pending, along with new claims 71-80. Claims 1-7, 34-47, and 53-70 have been withdrawn from consideration. Claims 71-80 have been added in order to claim the invention from additional perspectives. Support for the added claims can be found throughout the original specification, including the claims and drawings, and in particular at pages 11-12 and 45-50. The new claims are all substantially similar to one or more of claims 8-33, 48, 49, 51, and 52 and thus should not require additional searching by the Patent Office.

Claims 8-33, 48, 49, 51, and 52 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Minton (U.S. Pat. No. 6,014,643) in view of Dialog (T. Rowe Price Launches Site on World Wide Web to Serve as Educational Resource for Investors). This rejection is respectfully traversed.

With respect to claim 8, the Office Action states:

> Minton fails to explicitly disclose wherein at least some displayed data is updated with data transmitted over the network by the computer system without the user requesting any updates. Dialog, on the other hand, disclose a watch list and prices being updated automatically "without user intervention".

Applicants agree with the Patent Office that Minton fails to disclose a computer interface wherein at least some displayed data is updated with data transmitted over the network by the computer system without the user requesting any updates.

However, Applicants do not agree that Dialog discloses displayed data being updated with data transmitted over the network by a computer system without the user requesting any updates. Applicants are confused as to why the phrase "without user intervention" appears in quotation marks in the Office Action, since that phrase does not appear in the pending claims and does not appear in any of the cited references. Clarification is respectfully requested.

Paragraph 3 of Dialog states:

> The T. Rowe Price site, for example, offers weekly updates on the stock, bond, and international markets, economic reviews, access to free stock quotes, and daily prices on funds of the 15 largest mutual fund families. Investors can also establish a watch list of selected T. Rowe Price funds for daily net asset value updates, which appear automatically when they enter the site and input their codes.

Paragraph 6 of Dialog states: "The site features the following five main sections which will continually be updated."

Paragraph 7 (last sentence) states: "Quicken(A) users can download daily prices for T. Rowe Price funds into their own systems."

Paragraph 9 of Dialog states: "What's News: This section includes frequent market updates throughout the day, stock quotes, and weekly reviews of the fixed income, equity, and international markets and the U.S. economy."

Applicants respectfully submit that none of the above statements, either singly or in combination, discloses a computer interface wherein at least some displayed data is updated with data transmitted over the network by the computer system without the user requesting any updates.

Paragraph 3 discloses *weekly* updates and *daily* prices on funds. Neither of these values are updated without the user requesting an update. A value that only changes weekly or daily does not need to be updated at all, since it typically does not change during a user session.

Paragraph 3 also discloses *daily* updates for net asset values of funds, which appear automatically when the user enters the site. Although the words "update" and "automatically" appear here, they clearly are not being used in the sense of a value on a user's screen being updated without the user requesting the update: the user must do something (enter the site) each time he wishes to receive the update.

To "update" means, in the computer context, "to incorporate new or more accurate information."[1] Thus, certain information must first be present before it can be updated – otherwise, there is nothing for the new information to be incorporated into. For example, before price information can be *updated*, previously-received price information must be present. This is the sense in which the term "update" is commonly understood by those skilled in the art, and it is the sense in which the word is used in Applicants' application and claims. However, it is not clear that that is how the term is used in Dialog. For example, paragraph 3 states that daily net asset value "updates" appear automatically when users enter the site. If a user has not yet entered the site, it is unlikely that there would be a displayed daily net asset value to update. Thus, Dialog appears to be using the word "update" to include receiving any information at all, not just as receiving information used to revise information already present – and that is not how the term is commonly understood by those skilled in the art.

Finally, what is being "updated" in paragraph 3 of Dialog is not security-specific: the net asset value[2] of each fund on the watch list is all that is "updated." No securities prices are mentioned in paragraph 3 as being updated.

Thus, nothing in paragraph 3 discloses the user receiving actual *updates* to information of any kind. Information is received upon login, is the same throughout the day, and thus is not updated (in the usual sense). The only way a user apparently receives any information "automatically " is by entering the site – i.e., by requesting an "update," and claim 8 requires updates to be received by a user without being requested by the user.

Paragraph 6 states that sections of the site will "continually be updated," but the meaning of that phrase is unclear. It may mean that the sections of the site will be continually improved. It may mean that data on the server will be updated. But in any case there is no support for a presumption or assertion that information displayed to a user is updated without the user requesting an update.

---

[1] Webster's New Universal Unabridged Dictionary 2092 (1996)

[2] Net asset value is the total market value of all assets divided by the number of fund shares outsanding.

Paragraph 7 (last sentence) says that Quicken(A) users can download daily prices into their own systems. As discussed above, the facts that (a) the prices are merely *daily* prices, and (b) the users must *download* (i.e., request) the prices, each demonstrate that a system wherein at least some displayed data is updated with data transmitted over the network by the computer system without the user requesting any updates is not being referred to.

Paragraph 9 mentions frequent market updates throughout the day, stock quotes, etc., but it does not disclose a user receiving updates to displayed data without the user requesting any updates. Also, the term "market updates" is vague and ambiguous – it most likely simply refers to downloading values of market indexes, such as the Dow Jones Industrial Average, and not to prices of individual securities.

To summarize: no statement in Dialog discloses a user viewing data that is updated without the user requesting an update. The only sentence in which the word "automatically" appears makes clear that "automatically" means the user receives information upon entering the site. There is no indication that such information is ever updated after the user enters the site, and by entering the site the user is *requesting* the information. Moreover, the information displayed is merely net asset value or market index information– not orders, and not share prices.

Also, the Office Action states that Dialog discloses a watch list. As explained above, the watch list disclosed in Dialog is a watch list of funds - not of individual securities. And the data regarding each fund is net asset value of the fund, not prices of securities in the fund. Thus, Dialog does not disclose a watch list of securities, it does not disclose displaying prices of securities on a watch list, it does not disclose securities prices being updated automatically, and it does not disclose prices being updated without a user requesting the updates.

All rejections in the Office Action of claims 8-33, 48, 49, 51, and 52 are based on the assertion that Dialog discloses prices being updated automatically "without user intervention." As explained herein, that assertion is incorrect. Thus, all claim rejections are believed to have been overcome.

Moreover, claims 16-19 and 29-32 have been rejected over Minton in view of Fraser further in view of Dialog. The Patent Office states that Fraser discloses the display of a trade

ticket at column 7, lines 13-22. Fraser does mention a trade ticket at line 21 of column 7, but the term "trade ticket" is not defined and does not appear elsewhere in Fraser. The language in column 7 indicates that the trade ticket is used to keep track of trades, and that an associated reference number is displayed on a screen. Fraser does not disclose that the trade ticket itself is displayed, and does not describe what information regarding the trade is contained in the trade ticket. The mere fact that Fraser uses the same term as Applicants does not mean that Fraser discloses the same thing.

Furthermore, claim 16 claims a "a computer display of a trade ticket" – and Fraser does not disclose displaying a trade ticket. Thus, Fraser cannot be combined with Minton to disclose a trade ticket display as claimed in claim 16, for example. Moreover, Fraser, as the title indicates ("Automated Auction Protocol Processor") is directed to *auctioning* of *treasury securities* – not *trading* of *stocks*. Thus, one skilled in the art of stock trading would not be expected to be aware of Fraser, and there is no suggestion in the art to combine Fraser with either Minton or Dialog, to combine Fraser with the combination of Minton and Dialog, or to combine Dialog with the combination of Fraser and Minton.

Also, regarding claim 32, the Office Action states that although Minton, Fraser, and Dialog do not disclose pre-filling a trade ticket, it "would have been obvious to a person of ordinary skill in the trading arts at the time the invention was made to pre-fill the trade ticket in order to ensure that all trade information and conditions are obtained from trading participants." Applicants do not understand this statement. The reasons for pre-filling the trade ticket include increased speed and improved accuracy. Pre-filling the trade ticket does not ensure that all trade information is obtained any better than having a user manually complete all fields.

In any event, the mere fact that a claimed element is desirable does not make a claim obvious. Even if those skilled in the art at the time the invention was made knew that doing something was desirable, that doesn't mean that they knew how to do it, or even that doing it was possible using the art known at the time.

Claims 20 and 33 have been rejected in the Office Action under 35 U.S.C. § 103 over Minton, Fraser, and Dialog in view of Tull (U.S. Pat. No. 6,092,056). The Office Action

states that "the combination of Minton, Fraser and Dialog fails to explicitly disclose displaying the performance of the securities" and that Tull "on the other hand discloses performance of a financial instruments 'securities'. Not[e] abstract."

But the abstract of Tull actually states:

> A data processing system and method is disclosed for implementing and control of a financial instrument which is issued for a limited period of time. The instrument is based on an underlying basket of stocks optimally selected to track an established capital market and its price also reflects accrued investment income and maintenance expenses. The data processing system receives input from the capital market and periodically evaluates the performance of the financial instrument, reporting its price to customers. Also disclosed is a data processing system for administering an investment group of such instruments designed to track the performance of several domestic and foreign markets, estimate their return and provide current price information to customers.

Thus, Tull is directed to an instrument based on an underlying "basket" of stocks. The price of the instrument is reported to customers, but not the prices of the stocks. Note that claim 20 is directed to "software for simultaneously displaying non-overlapping computer display of performance of the securities." Claim 20 depends from claim 16, so "the securities" of claim 20 are the securities of claim 16 – i.e., securities on a "watch list of securities."

But the instrument described in Tull is not on a watch list created by the user – it is a single instrument "based on an underlying basket of stocks." Nor can the stocks on which the instrument is based be found on a watch list created by a user: they are "selected to track an established capital market," and they are not selected by a user, but by the claimed system. See, for example, column 7, lines 2-66. Therefore, they are not on a watch list of any kind, especially not a watch list created by a user. Thus, Tull does not disclose displaying performance of securities on a watch list to a user, as is required by claim 20.

Moreover, the combination of four different references by the Patent Office is an example of improper use of the Applicants' disclosure as a roadmap to combine disparate references. See MPEP § 2143.

Almost every invention is a combination of elements individually disclosed in the prior art. Thus, it cannot be permissible to try to find a reference that discloses each claimed element and then reject the claim as obvious in light of those references. There must be some teaching or suggestion of the desirability of combining such references.

Also, that teaching or suggestion must teach combining all cited references simultaneously, not sequentially. In other words, there is no support in the law for a rejection based on multiple suggestions to combine multiple references. There must be one suggestion to combine all references cited. That is, an Office Action may properly assert, if support is provided, that there is a suggestion to combine references A and B, but it cannot properly assert that there is a second suggestion to combine *the combination* of references A and B with reference C, or that there is a third suggestion to combine the combination of references A, B, and C with reference D, because support for such an assertion cannot exist.

That is because, although references A and B are in the prior art, the combination of references A and B is *not in the prior art*. Thus, there can be no suggestion in the prior art to combine reference C with the combination of references A and B, since the latter did not exist in the prior art. Similarly, since the combination of references A, B, and C is not in the prior art, there can be no suggestion in the prior art to combine reference D with the combination of references A, B, and C.

Thus, in the instant case, the Patent Office may properly argue, if support is provided, that there is a suggestion in the prior art that Minton be combined with Dialog, or that there is a suggestion in the prior art that Minton be combined with Fraser, or even that there is a suggestion to combine Minton, Dialog, and Fraser, although Applicants do not agree with such arguments and do not believe they are supported.

But the Patent Office cannot properly argue that there is a suggestion to combine the combination of Minton and Fraser with Dialog (as it does on section 5 of the Office Action),

since the combination of Minton and Fraser did not exist in the prior art. There could not have been a suggestion in the prior art to combine Dialog with something that did not exist.

Similarly, the Patent Office cannot properly argue that there was a suggestion in the prior art to combine Tull with the combination of Minton, Fraser, and Dialog, since that combination was not in the prior art.

In view of the foregoing, Applicants believe that all rejections have been overcome, that all of pending claims are in condition for allowance, and respectfully request the Patent Office to pass the subject application to issue.

Applicants believe the arguments herein more than suffice to overcome the rejections in the Office Action so, in the interests of efficiency, Applicants have not attempted to discuss every ground for withdrawing those rejections. Consequently, the fact that some grounds for allowing the claims may not have been discussed herein or in prior communications should not be taken as a waiver of the right to raise those grounds in the future.

No fee is believed due for filing this response. However, if a fee is due, please charge such fee to Pennie & Edmonds LLP's Deposit Account No. 16-1150.

Respectfully submitted,

Date: July 10, 2002

Steven P. Underwood (47,205)
For Francis E. Morris 24,615
(Reg. No.)

PENNIE & EDMONDS LLP
1155 Avenue of the Americas
New York, NY 10036-2811
(650) 493-4935